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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,996	06/22/2001	Satoshi Sakai	882A 3083	3366

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EXAMINER

ZURITA, JAMES H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/888,996

Applicant(s)

SAKAI ET AL.

Examiner

James H Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

On 31 January 2005, applicant cancelled claims 2-16, added claims 17-21 and amended claim 1.

Claims 1, 17-21 are pending and will be examined.

Response to Arguments

Objections to the drawings are withdrawn in view of amendment.

Objections to various claims are moot in view of amendment.

Rejections under 35 USC 101 are withdrawn in view of amendment.

Applicant's arguments concerning rejection of various claims are moot in view of new grounds for rejection.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

At the onset, the Examiner notes that limitations of claim 1 appear in language that is implied and not positively stated. The method steps occur outside the metes and bounds of the claims. As such, they carry little or no patentable weight. For example, the following language imply future actions:

wherein the credit posted to the [recipient-] account of the recipient **may be applied** to all or part of

1. the amount of **a future order** from any of said plurality of dealers **of a [future order] type** selected from the group consisting of
 - [order for] a purchase of merchandise for the recipient and
 - [order] for a purchase of a gift for another recipient not accompanied by an option to select and

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2 a service fee comprising a portion of said credit to an [recipient-] account of the recipient is deducted ***if the recipient uses said credit to purchase a gift of another recipient***

Claims 1, 17-21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hinrichs et al. (US PB-PUB 2001/0007098).

Hinrichs discloses methods for purchasing a gift for a recipient from a plurality of merchants (applicant's merchants; see, for example at least Fig. 11 and related text) on the same Internet site (see, for example, at least paragraph 8) comprising steps of ***accepting*** through Internet for one of said plurality of merchants (merchants) an order of the type selected from the group consisting of

- [order for] a purchase of a gift not accompanied by an option to select. See, for example, at least references to specific premiums chosen for an occasion, as in paragraph 5).
- [order for] a purchase of a gift accompanied by an option to select;. See, for example, at least references to letting an employee select a premium from a catalog, as in paragraph 6)

crediting a nomination fee to a [merchant-] account of said one of said plurality of merchants, said nomination fee comprising a portion of a purchase price of said gift ordered. See, for example, at least references to crediting amounts to award and gift account(s) as in paragraph 21. see also references made to merchants from shopping cart company, as in paragraph 9.

making an unconditional delivery upon acceptance of an order of said gift not accompanied by an option to select, in which the necessary arrangements are

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made for the unconditional delivery of the gift, as designated by the orderer, without granting the recipient an option to select and crediting said [merchant-] account of said one of said plurality of merchants with the remainder of said purchase price. See, for example, at least references to specific premiums, paragraph 5, and shipping addresses, as in paragraph 60).

granting through Internet the recipient an option to select upon acceptance of an order for the purchase of said gift accompanied by an option to select, in which the designated recipient is informed of a content of the gift (as in gift accounts established for an employee, paragraph 21) and is granted an option of selecting from a set of choices, including "take" (as in using his gift account for purchases) and "credit" (as in using account balance to offset purchases and having remaining funds). See, for example, crediting funds to another recipient, such as a charity, as in paragraph 68.

responding through Internet to a selection by the recipient, whereby if the recipient selects the "take," the necessary arrangements are made to deliver to the recipient the gift. See above, for example, concerning ***making an unconditional delivery*** upon acceptance of an order of said gift not accompanied by an option to select, in which the necessary arrangements are made for the unconditional delivery of the gift, as designated by the orderer, without granting the recipient an option to select and crediting said [merchant-] account of said one of said plurality of merchants with the remainder of said purchase price. See, for example, at least references to specific premiums, paragraph 5, and shipping addresses, as in paragraph 60).

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crediting said [merchant-] account of said one of said plurality of merchants with a remainder of said ***purchase price***. See, for example, crediting a merchant's account with credit equal to purchases that are applied against certifications, as in the Abstract. See also at least paragraph 9 concerning pre-arranged procedures between a shopping cart and merchants. if the recipient selects the "credit," a credit is posted to the [recipient-] account of the recipient, in accordance with the ***purchase price*** of the a gift less said nomination fee. See paragraph 9 for payments to merchants, for example.

Hinrichs discloses that credit(s) posted to the [recipient-] account of the recipient may be applied to all or part of a future order from any of said plurality of merchants of a [future order] type selected from the group consisting of [order for] a purchase of merchandise for the recipient. See, for example, references to future visits and logons by recipients, as in future direct access, in paragraph 74, for example. For orders for a purchase of a gift for another recipient **not** accompanied by an option to select (see, for example, at least references transferring credits from a gift account to a charity account, at in paragraph 68.

Hinrichs ***does not*** specifically disclose

wherein the credit posted to the [recipient-] account of the recipient ***may be applied*** to all or part of

2. the amount of ***a future order*** from any of said plurality of dealers ***of a [future order] type*** selected from the group consisting of

- [order for] a purchase of merchandise for the recipient and
- [order] for a purchase of a gift for another recipient not accompanied by an option to select and

2 a service fee comprising a portion of said credit to an [recipient-] account of the recipient is deducted ***if the recipient uses said credit to purchase a gift of another recipient***

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However, as noted above, the limitations appear in language that is implied and not positively stated. The method steps occur outside the metes and bounds of the claims. As such, the cited claim language carries little or no patentable weight. The steps of accepting, crediting, making an unconditional delivery, granting, responding, making an unconditional delivery and crediting would be performed the same. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Hinrichs to disclose future uses of credits, as in paragraph 68, for example, for the obvious reason that such actions to not impact on the method steps.

Hinrichs **does not** specifically disclose that a service fee comprising a portion of said credit to an [recipient-] account of the recipient is deducted if the recipient uses said credit to purchase a gift of another recipient. Hinrichs discloses various charges that are made against various accounts, including employee accounts, company account, service provider account as necessary.

As noted previously, Returning Gifts discloses various fees that may be applied to accounts for various services. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Hinrichs with general knowledge to disclose that a service fee comprising a portion of said credit to an [recipient-] account of the recipient is deducted if the recipient uses said credit to purchase a gift of another recipient.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Hinrichs with general knowledge to disclose that a service fee comprising a portion of said credit to an [recipient-] account of the

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recipient is deducted if the recipient uses said credit to purchase a gift of another recipient for the obvious reason that managing a site often requires use of resources by the managers of various accounts. By charging a fee for various services, a site and its members may reduce their overall costs and increase their own profits, which in turn may lead to more jobs.

As per claim 17, Hinrichs does not specifically disclose the steps of operating, maintaining and managing a system for said method of purchasing a gift for a recipient by a service provider (applicant's **broker**) wherein said service provider receives a fee from each purchase comprising a portion of said purchase price of each gift. It is well known that service providers often provide their services for a fee. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Hinrichs and general knowledge to disclose that said service provider receives a fee from each purchase comprising a portion of said purchase price of each gift. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Hinrichs and general knowledge to disclose that said service provider receives a fee from each purchase comprising a portion of said purchase price of each gift for the obvious reason that as a business, a provider needs revenue to operate. One way of obtaining such revenue is from acting as intermediary for purchases.

As per claims 18-21, Hinrichs **does not** specifically disclose use of applicant's formulas for calculating various fees. Hinrichs does not refer to

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various fees with applicant's labels, including service fee, brokerage fee, nomination fee.

However, the labels given to various actors and modules are not functionally related to the substrate of the article of manufacture. The labels themselves carry little or no patentable weight. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply a label to various actors and modules in a system such as Hinrich because such data does not functionally relate to the substrate of the article of manufacture and merely labeling the data differently from that in the prior art would have been obvious. See *Gulack* cited above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory

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period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James Zurita
Patent Examiner
Art Unit 32625
10 May 2005

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